

REMARKS

Claims 1-15, 17-21 and 28-56 currently are pending. Upon entry of the above amendments, claims 14, 15, 21, and 51 shall be amended to correct minor typographical errors and to otherwise improve readability. Claim 54 shall be amended to correct an inadvertent error in its dependency. Applicants respectfully submit that this change to claim 54 would not present any new issues because this claim recites "said use-triggered condition," which clearly refers to the "use-triggered condition" first introduced in claim 53. It is respectfully submitted that the forgoing amendments should be entered because they do not present new issues that would require further search or consideration, would place the application in condition for allowance, or would otherwise serve to simplify the issues for appeal.

In view of the remarks that follow, Applicants respectfully request reconsideration and withdrawal of the rejection of the claims.

The Office Action includes a rejection of claims 1-15, 17-21 and 28-56 under 35 U.S.C. § 103, as allegedly being unpatentable over U.S. Patent No. 6,163,771 to Walker et al. in view of U.S. Patent No. 6,163,771 to Austin. This rejection is respectfully traversed.

The Office Action essentially alleges that the Walker et al. patent teaches all the claimed features except for use-triggered deactivation. It is to be noted that the Action does not discuss any complete combination of features recited in any one independent claim, much less the dependent claims. Rather, it selectively reads features gathered from several claims, fails to mention a number of claimed limitations, and discusses other claimed limitations only in general terms with respect to the Walker et al. patent. As pointed out below, the pending claims recite combinations of features that set forth subject matter not taught or suggested in the Walker et al. patent. Furthermore, it is respectfully submitted that the Office's reliance on the Austin patent fails to consider Applicants' claim for foreign priority with respect to several of the pending claims, and that this patent does not otherwise teach or suggest claimed subject matter missing in the Walker et al. disclosure.

The Filing Dates of All Priority Documents Predate the Filing Date of the Austin Patent

The present application is a divisional of Application No. 09/235,836 ("the '836 application"), now U.S. Patent No. 6,636,833, and claims benefit of priority from Irish Patent Applications Nos. S980223, S980346, and S980458, which were respectively filed on March 25, 1998, May 7, 1998, and June 15, 1998. Certified copies of these English language documents were submitted in the '836 application. Applicants submit that the subject matter of independent claims 1, 14, 15, 17, 20, 21 and 51, and at least dependent claims 2-13, 18, 19, 28-30, 32-35, 37, 52, 53 and 55, is fully supported by the Irish priority documents. Because the priority documents predate the June 22, 1998 U.S. filing date of the Austin patent, the Austin patent has been overcome under the provisions of 35 U.S.C. § 119, with respect to these claims. For at least this reason, the rejection of claims 1-15, 17-21, 28-30, 32-35, 37, 51, 52, 53 and 55 should be withdrawn.

Walker et al. Fails to Teach All Claimed Limitations

Before proceeding with an analysis of the differences between the claims and the Walker et al. patent, it should be pointed out that the Office Action includes the statement: "Walker et al. shows all of the limitations of the claims except for use-triggered deactivation," which appears to imply that all claims recite language concerning use-triggered deactivation. Such language, however, is not recited in every claim. For instance, independent claim 51 does not recite language concerning use-triggered deactivation. In any event, it is respectfully submitted that the Walker et al. patent not only fails to disclose this feature as recited in claims 1-15, 17-21 and 28-50, but it does not teach or suggest a number of other specific features recited in the pending claims.

Independent claim 1 is directed to a credit card system that includes, *inter alia*, means for associating at least one limited-use credit card number with limited-use conditions. The limited-use conditions include *permitting multiple uses*. Independent claims 14 and 15 also recite that the limited-use conditions include permitting *multiple uses* of the limited-use credit card number. Similar distinctions are brought out in independent claims 17 and 20. For

instance, claims 17 and 20 respectively recite a means for, and process of processing a transaction that includes determining whether a use-triggered condition has occurred, and generating a deactivation command if it has occurred, and *not* generating a deactivation command if the use-triggered condition has not occurred. It is respectfully submitted that the Walker et al. patent fails to teach or suggest these claimed features, as pointed out in Applicants' response of November 20, 2003:

To the contrary, the *Walker* patent is directed to a method and a device for generating a single-use financial account number. (See, column 1, lines 6-8.) There is no suggestion in the *Walker* patent concerning any multiple use of a credit card number that is subject to deactivation upon a use-triggered condition, as claimed. For instance, the *Walker* patent teaches generating each number using a user-controlled device that increments an initialization variable used in the number. Each initialization variable of a credit card number used in a transaction is stored in a credit card transaction database to prevent against "replay" attacks. (See, column 7, lines 42-51, column 10, lines 10-21). Another way *Walker* attempts to prevent a credit card number being used more than once involves a processor in the device updating, when a credit card number is approved for a transaction, a status indicator in a credit card database memory from "not used" to "used." (See, column 11, lines 59-62 and column 12, lines 39-44.) Hence, the credit card system disclosed in the *Walker* patent actually "teaches away" from a limited-use credit card number permitting multiple uses and a use-triggered condition as claimed.

(See the November 20, 2003 Amendment, the paragraph spanning pages 16-17.) The Office Action states that these arguments were considered "moot in view of the new ground(s) of rejection." Applicants respectfully disagree and submit that these arguments are relevant to the present rejection.

With respect to independent claim 51, it has been noted above that the rejection of this claim is overcome, if for no other reason than the rejection relies on the Austin patent, which has a later filing date than the above-noted Irish priority documents. Moreover, it is respectfully submitted that the Walker et al. patent does not teach or suggest the combination including every feature recited in this claim. For instance, claim 51 recites that a credit card system includes, *inter alia*, a receiving unit for receiving information from a user of said master credit card, said information defining at least one said limited use of said limited-use

credit card number, before using said limited use card number in a transaction pertaining to said defined limited use. In contrast, the Walker et al. patent describes a system in which a single-use, transaction specific credit card number is generated only *after* the cardholder submits transaction specific information. (See, column 6, lines 17-18, 25-27 and 30-33.) To the extent that the Walker et al. patent describes a cardholder providing information defining a use of a single-use credit card number, it is in the context of providing transaction-specific information (i.e., a purchase amount and a merchant code number), which is then used by the device 100 to *generate* a credit card number unique to the user-provided information (i.e., the information must be provided *before* the number is generated). Walker et al. does not teach or suggest that a user defines a limited use for a number *before that number* is used in a transaction pertaining to the defined limited use, as claimed, because the number used in a transaction does not yet exist when providing this information. For at least this additional reason, the rejection of claim 51 should be withdrawn.

**The Walker et al. and Austin Patents Fail to Establish a
Prima Facie Case with Respect to Independent Claims 39-50**

Independent claims 39 and 44 are respectively directed to a credit card system and method for implementing a credit card system which include a first queue of limited-use credit card numbers, each available for association with one master credit card number, and second queue containing assigned master credit card numbers requiring association with limited-use credit card numbers. For example, as described in specification, at page 20, lines 10-27, the allocation of credit card numbers from a list to a customer in a queue of customers requiring numbers provides randomness, which prevents the derivation or prediction of a next set of numbers that a particular credit card holder will be allocated. The Office Action, however, does not point to any part(s) of the Walker et al. and Austin patents that would have taught or suggested these claimed features. It is respectfully submitted that these documents do not teach or suggest anything whatsoever concerning a first and second queue, as claimed. For at least this reason, the rejection of independent claims 39 and 45 should be withdrawn.

Claims 40-44 and 46-50 respectively depend from one of independent claims 39 and 45 and are, therefore, allowable at least for the reasons given above, and further for the additional features recited.

Dependent Claims 31, 36, 38, 54 and 56

Claim 31, which depends from claim 1, recites that the limited-use conditions include limiting the limited-use credit card number to *a predetermined number of payments* for a transaction with a single merchant. For at least the above reasons, it is respectfully submitted that the disclosure of a *single-use* card number in the Walker et al. patent does not teach or suggest, and in fact, teaches away from a limited-use for a credit card number that involves more than one payment. The Austin patent, likewise, does not suggest this claimed feature. According to Austin, a credit card number is "adapted for one-time use." (See column 1, lines 7-8.) In the system described in Austin, after an approval signal to a vendor, "the credit card number is canceled and cannot be used again." (See column 2, lines 35-45. Also see, column 5, line 66 to column 6, line 1.) Hence, neither the Austin patent nor the Walker et al. patent would have led one of ordinary skill in the art to arrive at the claimed limited-use conditions that include limiting the limited-use credit card number to *a predetermined number of payments* for a transaction with a single merchant. As such, no *prima facie* case of obviousness has been established. Claim 31 is therefore allowable over these documents.

With respect to dependent claims 36 and 38, it is respectfully submitted that these claims are allowable at least because of their dependence from independent claim 21, which recites that a credit card system comprises, *inter alia*, "means for receiving information from said user, said information specifying limited uses for *the limited-use credit card number*, said uses including said use-triggered condition." As mentioned above, the Walker et al. system does not generate a credit card number until *after* information is received from a credit card number user. For reasons similar to those given above with respect to claim 51, Applicants respectfully submit that claim 21, and hence also dependent claims 36 and 38 are allowable.

Each of dependent claims 54 and 56 recites a combination of features defining additional, separately patentable subject matter not taught or suggested the applied Walker et al. patent, whether this patent is considered alone or in any combination with the Austin patent. For example, claim 54 recites that the user-defined limited use, which designates the limited-use credit card number for *multiple uses* until deactivation upon occurrence of a use-triggered condition, and includes a use-triggered condition that is satisfied when charges accrued by the limited-use card number exceed at least one predetermined threshold selected from a total single charge, total charges over a limited time period, and total charge in a single transaction. The Walker et al. and Austin patents, by contrast, do not permit multiple uses of a credit card number. Indeed, the credit card numbers of both systems of Walker et al. and Austin are designated for *only one use*. Dependent claim 56 recites that the defined limited use limits use of the limited-use credit card number to *transactions* with a specific merchant by first use. It is respectfully submitted that neither Walker et al. nor Austin teach or suggest these claimed features because, as noted above, both these patents are directed to only single-use credit card numbers. Moreover, because there is no mention in these patents of more than one transaction, it necessarily follows that there is no teaching or suggestion of transactions limited to a specific merchant as determined by first use, as recited in claim 56.

For all the foregoing reasons, Applicants respectfully submit that the present application is in condition for allowance. Prompt notification of same is earnestly solicited.

Respectfully submitted,

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